

REMARKS

Status of the claims:

Claims 1 and 3-11 are pending with claims 9-11 having been withdrawn from a prior restriction requirement. Thus, claims 1 and 3-8 are ready for further action on the merits. Reconsideration is respectfully requested in light of the following remarks.

Election/Restriction

The Examiner has restricted claim 11 asserting that it is a method claim that does not fall within the scope of the originally elected invention. Applicants respectfully request that the Examiner consider rejoinder of claim 11 in accordance with the holding *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995) should method claim 11 be found to be of the same scope or narrower than any independent product claim that issues.

Rejections under 35 USC §102

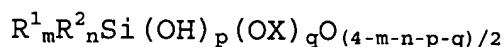
Claims 1 and 3-8 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Yamaya '355 (EP 0 841 355 A2).

Applicants traverse.

The present invention, as recited in claim 1, relates to an ink jet printing paper sheet comprising cellulose fibers coated

at least in part upon paper making with solids of a substantially organic solvent-free, silicone resin-containing emulsion composition which is obtained by emulsion polymerization of a mixture comprising:

(a) 100 parts by weight of at least one of (a-1) a singly water insoluble, silanol group-bearing silicone resin having the following average compositional formula:



wherein  $R^1$  is a monovalent hydrocarbon group having 1 to 10 carbon atoms,  $R^2$  is a substituted monovalent hydrocarbon group having 1 to 10 carbon atoms, X is a monovalent hydrocarbon group having 1 to 6 carbon atoms, m, n, p and q are positive numbers satisfying  $0.5 \leq m \leq 1.8$ ,  $0 \leq n \leq 1.0$ ,  $0 < p \leq 1.5$ ,  $0 \leq q \leq 0.5$ ,  $0.5 \leq m+n \leq 1.8$ ,  $0 < p+q \leq 1.5$ , and  $0.5 < m+n+p+q < 3$ , and (a-2) a radical polymerizable vinyl group-bearing alkoxy silane having the following general formula:



wherein  $R^3$  is hydrogen or methyl,  $R^4$  is a divalent hydrocarbon group of 1 to 10 carbon atoms which may be separated by an oxygen atom, -COO- group or the like,  $R^5$  is a substituted or unsubstituted monovalent hydrocarbon group having 1 to 8 carbon

atoms, X is as defined above, "a" is 0 or 1, and "b" is 0 or 1, and

(b) 100 to 100,000 parts by weight of a radical polymerizable vinyl monomer.

When cellulose fibers of paper are coated at least in part upon paper making with solids of a substantially organic solvent-free, silicone resin-containing emulsion composition obtained by emulsion polymerizing a mixture containing a silanol group-bearing silicone resin and/or a radical polymerizable vinyl group-bearing alkoxy silane and a radical polymerizable vinyl monomer, there is obtained an ink jet printing paper sheet which when printed by an ink jet printer, is minimized in deformation or stretching/contraction and affords a high color development density, gloss and sharp hue.

Yamaya '355 fails to disclose ink jet printing paper obtained by coating cellulose fibers of paper upon paper making at least in part. Yamaya '355 only discloses a coating layer on paper sheets by applying the composition thereon.

In order to comply with the Examiner's request in the Office Action of May 10, 2004, Applicants, herein, present the attached 37 C.F.R. §1.132 declaration showing the superiority of the paper product of the instant invention relative to the paper product of Yamaya '355.

In the declaration, the Examiner should note that the comparison examples (sample numbers 1 to 7) are paper that have synthesis examples 1 to 7 (as disclosed in the instant written description) added by means of a coater. These examples are paper sheets that have the coating added by the method employed by Yamaya '355. In contrast, the invention examples (sample numbers 11-17) are paper that have synthesis examples 1 to 7 (as disclosed in the instant written description) added to the paper wherein the cellulose fibers are coated at least in part upon paper making (as is claimed in the instant invention).

The Examiner's attention is directed to Tables 1 and 2 of the declaration (on pages 5 and 6, respectively) wherein the fixation of the printed image, the water resistance of the printed image, the dimensional stability to water of the printed paper sheet and the curl properties of the paper in various humid conditions for each of the papers are reported. The Examiner should note that in all cases the paper of the instant invention (wherein cellulose fibers are coated at least in part upon paper making) are superior to the paper wherein coating takes place after the paper has been made.

With this showing, Applicants have shown that the process element "wherein the cellulose fibers are coated at least in part upon paper making" is an element that should be considered as part of the claim as it does lead to a physically different

product. Applicants believe that with the submitted declaration and the above explanation, that the rejection has been obviated. Withdrawal of the rejection is warranted and respectfully requested.

With the above remarks, Applicants believe that the claims, as they now stand, define patentable subject matter such that passage of the instant invention to allowance is warranted. A Notice to that effect is earnestly solicited.

If any questions remain regarding the above matters, please contact Applicant's representative, T. Benjamin Schroeder (Reg. No. 50,990), in the Washington metropolitan area at the phone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment: 37 C.F.R. §1.132 declaration